

FIG. 1

Attorney Ref.: IND-110(US)

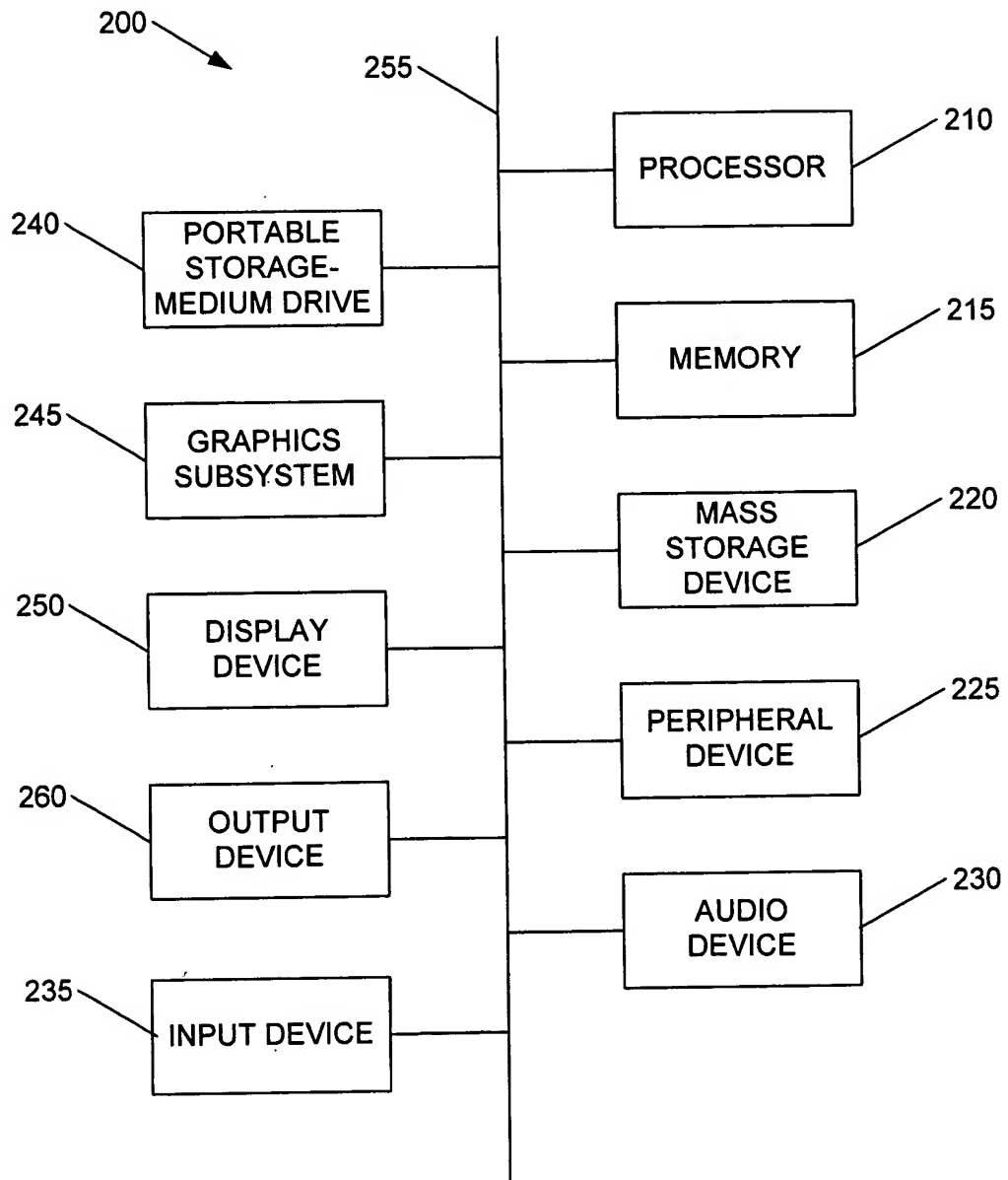


FIG. 2

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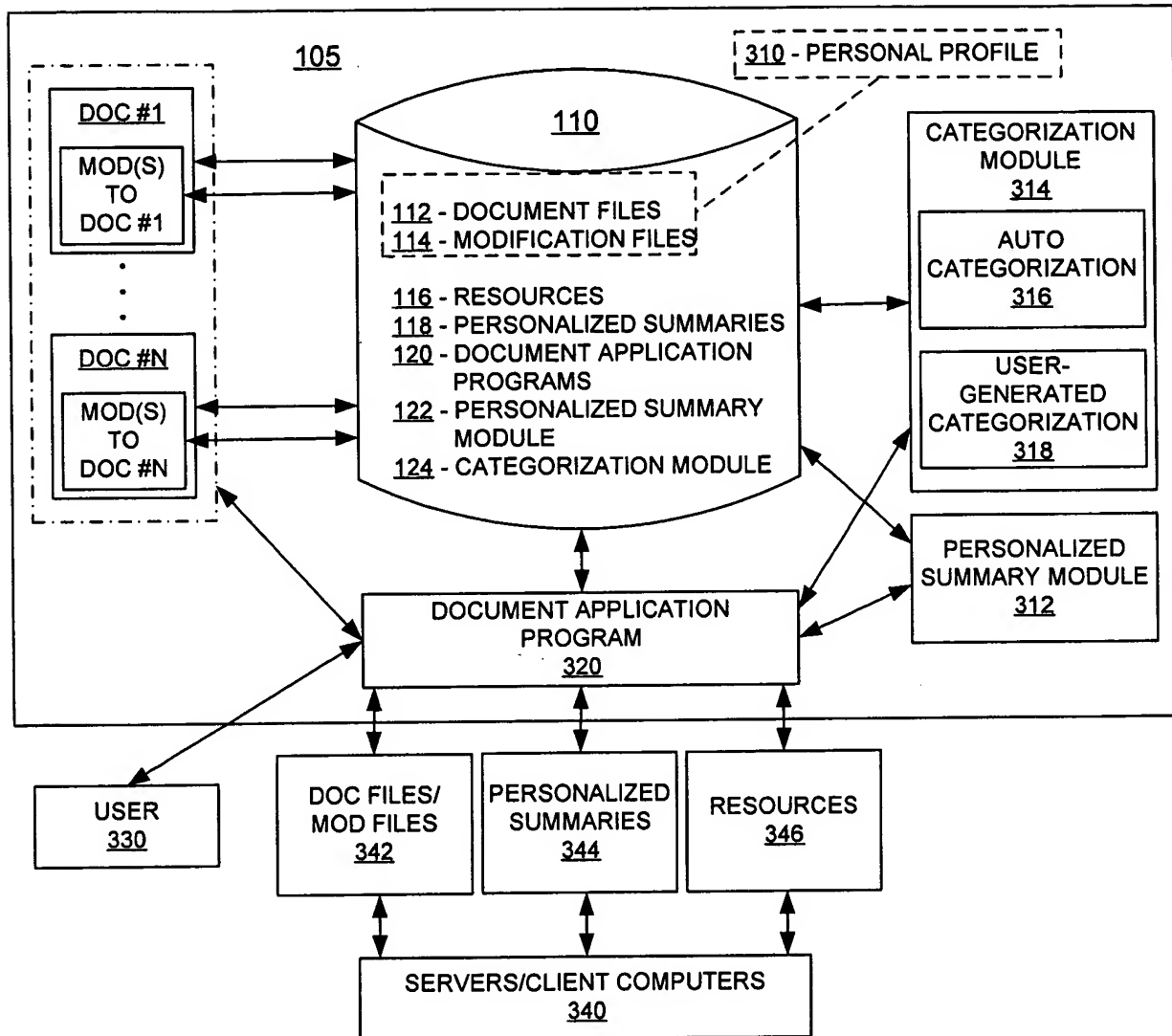


FIG. 3a

SUPREME COURT OF THE UNITED STATES ~ 347

FESTO CORP., PETITIONER V. SHOKEITSU KINZOKU KOGYO KABUSHIKI CO., LTD., ET AL.

JUSTICE KENNEDY delivered the opinion of the Court. ~ 350

This case requires us to address once again the relation between two patent law concepts, the doctrine of equivalents and the rule of prosecution history estoppel. The Court considered the same concepts in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U. S. 17 (1997), and reaffirmed that a patent protects its holder against efforts of copyists to evade liability for infringement by making only insubstantial changes to a patented invention.

* * *

A

The first question in this case concerns the kinds of amendments that may give rise to estoppel. Petitioner argues that estoppel should arise when amendments are intended to narrow the subject matter of the patented invention, for instance, amendments to avoid prior art, but not when the amendments are made to comply with requirements concerning the form of the patent application. In *Warner-Jenkinson* we recognized that prosecution history estoppel does not arise in every instance when a patent application is amended.

* * *

Indeed, we stated that even if the amendment's purpose were unrelated to patentability, the court might consider whether it was the kind of reason that nonetheless might require resort to the estoppel doctrine. *Id.*, at 40-41.

* * *

A patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the broader subject matter, whether the amendment was made to avoid the prior art or to comply with § 112.

See Festo below

We must regard the patentee as having conceded an inability to claim broader subject matter or at least as having abandoned his right to appeal a rejection. In either case estoppel may apply.

Mutatis Mutandis

①

Note:
ESTOPPEL =
LEGAL BAR TO
ALLEGING OR
DENYING A
FACT

②

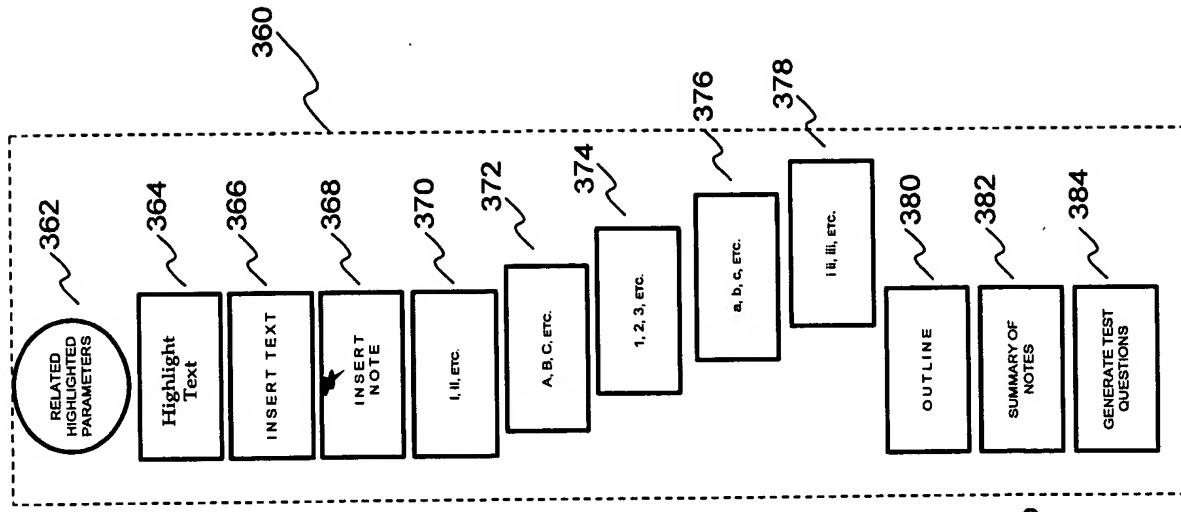
Note:
§ 112 = WRITTEN
DESCRIPTION
ENABLEMENT
TEST

366b

110156634

FIG. 3(b)

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I. FESTO CORP., PETITIONER V. SHOKETSU KINZOKU KOGYO KABUSHIKI CO

A. Issue – to address once again the relation between doctrine of equivalents and the rule of prosecution history estoppel.

1. First Question: The first question in this case concerns the kinds of amendments that may give rise to estoppel¹.

(a) Answer: A patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the broader subject matter, whether the amendment was made to avoid the prior art or to comply with §112².

(i) We must regard the patentee as having conceded an inability to claim the broader subject matter or at least as having abandoned his right to appeal a rejection.

¹ Estoppel = legal bar to alleging or denying a fact
² 112 = written description/enabement test

Test Questions:

- Which of the following may give rise to prosecution history estoppel?
 - a. A patentee amended his patent application
 - b. A patentee narrows a claim as a condition to obtaining a patent
 - c. A patentee disavows his claim to the broader subject matter
 - d. All of the above
 - e. None of the above

(Key: (d))

- A disavowing statement made by a patentee during prosecution may prevent the patentee from reasserting his right because
 - a. The court regards the patentee's disavowing statement true
 - b. The patentee's amendment is unrelated to the subject matter
 - c. The patentee has conceded an inability to claim the broader subject matter and at least has abandoned his right to appeal a rejection
 - d. The court agreed that the patentee is not capable of claiming a broader subject matter
 - e. The court does not allow the patentee to assert his right

(Key: (c))

FIG. 3(d)

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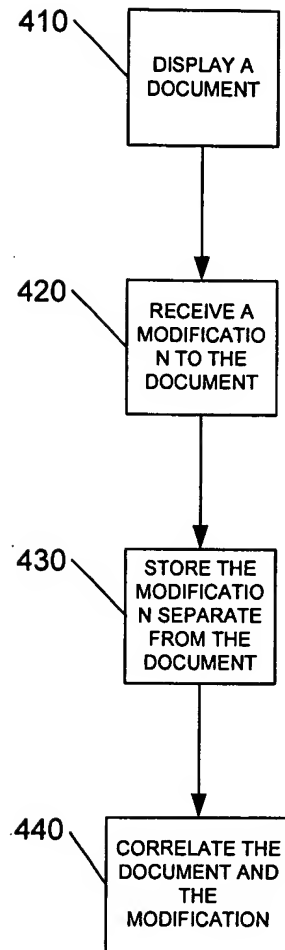


FIG. 4

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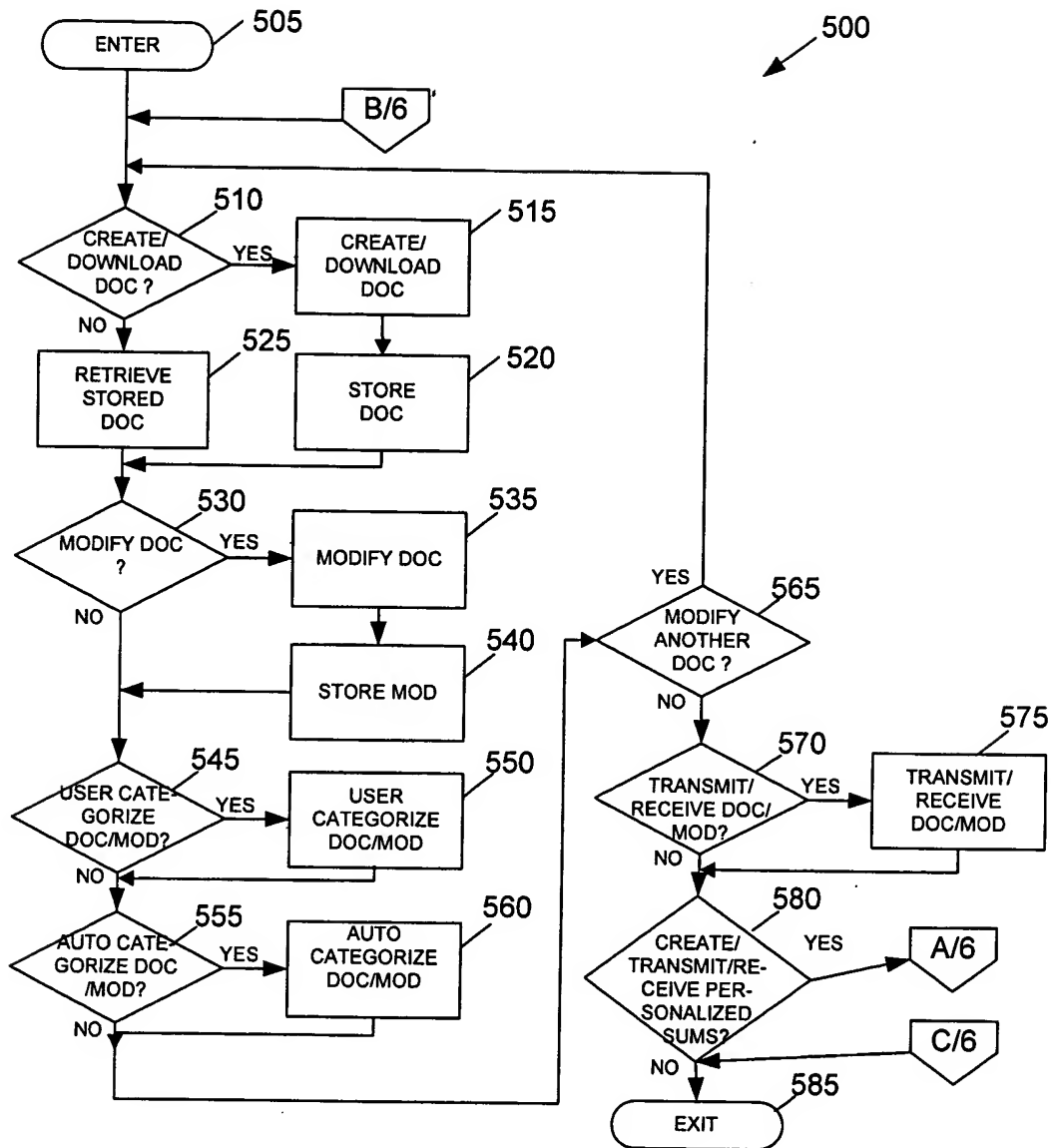


FIG. 5

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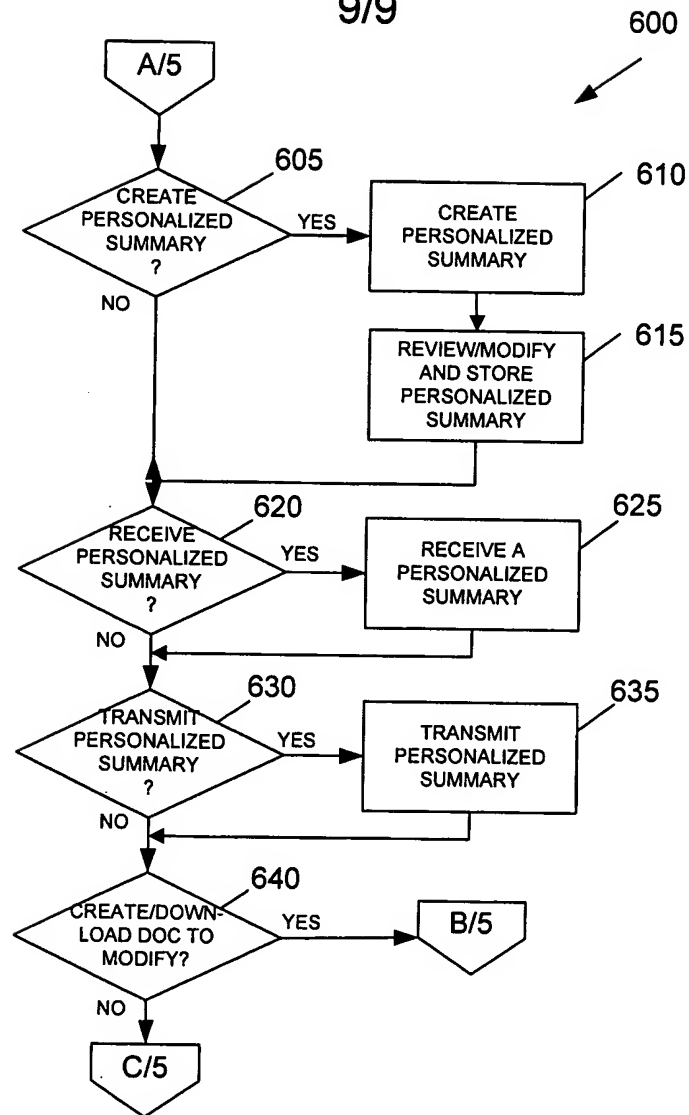


FIG. 6

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